

Remarks:

Reconsideration of the application is requested. Claims 1-2, 6-18, and 20-30 are now in the application. Claims 1, 6-8, 10, 16, 20, 23, 25, 27, and 28 have been amended. Claims 3-5 and 19 have been canceled.

In item 2 of the Office action, the Examiner stated that the previously submitted power of attorney was illegible. A replacement power of attorney was submitted on May 2, 2007. The power of attorney specifies Customer Number 54962.

In item 3 of the Office action, the Examiner objected to claims 5-8. In particular, the Examiner objected to claim 5 for simply using the term " $\lambda$ " and not explaining what  $\lambda$  defines. While claim 5 has been canceled, its features have been integrated into claim 1. Claim 1 has been amended to change " $\lambda$ " to --time constant ( $\lambda$ )-- as suggested by the Examiner. Likewise, claim 7 has been amended in the same way to explain that  $\lambda$  is defining the time constant.

In addition, item 2 of the office action, the Examiner objected to claim 8 for using the term "IGBT" without defining it as a "Insulated Gate Bipolar Transistor". Claims 8 has been amended to explicitly describe that IGBT means Insulated Gate Bipolar

Transistor. Likewise, claim 28 has been amended to make this explanation explicit.

The above described changes are to correct formalities and are neither made for the statutory requirements of a patent nor the prior art.

In item 5 of the above-identified Office action, the Examiner has rejected claim 1 as being indefinite under 35 U.S.C. § 112, first paragraph. More specifically, the Examiner has stated that the claim contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention. In particular, the Examiner stated that no support in the specification existed for the limitation, "when said coil is 5 cm from the tissue."

An object of the invention of the instant application is to provide a noninvasive therapeutic device. Accordingly, an object is to provide a device that operates at a distance from the tissue being treated. A further object is to provide a device that can penetrate tissue. Therefore, it is important that the device can create the therapeutic field at a distance of at least five centimeters from the tissue being treated. In

addition, one with ordinary skill in the art would know that field strength diminishes with respect to the distance from the coil. Therefore, to describe a noninvasive device, a strength of the field from a coil should include a distance from the coil to have any meaning.

Throughout the specification, applicants have measured the field strength at a distance of 5 cm from the face of the coil. See *for example*, Specification, page 20, line 2; Abstract, line 5; and originally-filed claim 1.

One skilled in the art reading the claim would understand that claims describe a device that generates a magnetic field that inducts an electric field in the tissue of at least 10 mV/cm when the coil is at a distance of 5 cm from the tissue. Because one with ordinary skill in the art could practice the invention as claimed, claim 1 is enabled.

If the Examiner is still convinced, Applicant asks that she calls the undersigned attorney because alternatives may be possible.

In item 6 of the Office action, the Examiner rejected claim 1 as failing to comply with the written description requirement. In

particular, the Examiner pointed out that the specification, page 24, ll 17-23, taught that the electric field needed to be greater than 10 mV/cm to be effective. The claims have been amended pursuant to this section to specify that the magnetic field is powerful enough to generate an electric field greater than 10 mV/cm. While Applicant has evidence that electric fields as little as 1 mV/cm are effective and the specification explicitly states this amount, Applicant is willing to amend the claims to 10 mV/cm in order to advance prosecution towards allowance.

Accordingly, the specification and the claims meet the requirements of 35 U.S.C. § 112, first paragraph. Should the Examiner find any further items, counsel would appreciate a telephone call during which the matter may be resolved. The changes are neither provided for overcoming the prior art nor do they narrow the scope of the claim for any reason related to the statutory requirements for a patent.

Applicant also notes that repeated calls to the Examiner were made prior to this response in order to clear the § 112 rejections before filing this formal response. These calls were mostly unanswered. Should the Examiner not be fully satisfied

with the claims, she again is asked to call so the issues may be rectified without the delay of an Office action.

In items 7-13 of the Office action, the Examiner rejected claims 1-4, 6, 9, 12-18, 21-22, 24, and 26 under 35 USC §§ 102 and 103. As explained below, these claims or their underlying base claims have been amended to include allowable subject matter. Accordingly, the rejections are now moot.

In item 14 of the Office action, the Examiner objected to claims 5, 7-8, 10-11, 19-20, 23, 25, and 27-30 but indicated that those claims included patentable subject matter that would be allowed if rewritten as independent claims containing all of the subject matter of any underlying and intervening claims.

Claim 1 has been amended to include the features of claims 3-5. Claims 3-5 have been canceled. Claim 2 is an intervening claim, however, its features have not been added because the features of claim 2 are not needed according to the Allowable Subject Matter section of the Office action. If Applicant's conclusion regarding claim 2 was incorrect, Applicant asks the Examiner to call so that necessary changes can be made telephonically, without a formal action.

Claim 7 has been rewritten as an independent claim including the features of claims 1, 3, and 4. Claim 2 is an intervening claim; however, its features have not been added because the features of claim 2 are not needed according to the Allowable Subject Matter section of the Office action.

Claim 8 has been rewritten as an independent claim including the features of claims 1, 3, and 4. Claim 2 is an intervening claim, however, its features have not been added because the features of claim 2 are not needed according to the Allowable Subject Matter section of the Office action.

Claim 10 has been rewritten as an independent claim including the features of claims 1.

Claim 16 has been amended to include the features of claim 19.  
Claim 19 has been canceled.

Claim 20 has been amended to depend on claim 16.

Claim 23 has been rewritten as an independent claim that includes all of the features of claim 16 (previous to this amendment).

Claim 25 has been rewritten as an independent claim that includes all of the features of claim 16 (previous to this amendment).

Claim 27 has been rewritten as an independent claim that includes all of the features of claim 16 (previous to this amendment).

Claims 2, 6, 9, 12-15 ultimately depend from claim 1 and are allowable for at least the same reasons as claim 1.

Claim 11 is dependent on claim 10 and is allowable at least for the same reasons as claim 10.

Claims 17-18, 20-22, 24, 26 ultimately depend on claim 16 and are allowable for at least the same reasons as claim 16.

Claims 28-30 ultimately depend on claim 27 and are allowable at least for the same reasons as claim 27.

In view of the foregoing, reconsideration and allowance of claims 1-2, 6-18, and 20-30 are solicited. In the event the Examiner should still find any of the claims to be unpatentable,

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please telephone counsel so that patentable language can be substituted.

If an extension of time for this paper is required, petition for extension is herewith made.

A fee of \$500 is attached to provide for five additional independent claims in excess of three. Please charge any required fee (or credit any overpayments of fees) to the Deposit Account of the undersigned, Account No. 500601 (Docket No. 1047-A07-002).

Respectfully submitted,  
/Loren D. Pearson/  
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